

REMARKS

Election of Claims

Responsive to the Restriction Requirement dated February 3, 2003, the claims of Group V (Claims 13, 30-32) drawn to a magnetic field sensor with a matrix of magnetostrictive material and at least one rod or fiber of piezoelectric material surrounded by the matrix are provisionally elected for prosecution, with traverse. Applicant reserves the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicant does not hereby abandon or waive any rights in the non-elected inventions.

The requirement is being traversed for the reasons set forth in detail below.

The eight-way restriction requirement issued on February 3, 2003 should be withdrawn because the Examiner has not made a sufficient showing that the claims of Groups I-VIII are independent or distinct as claimed. As explained in MPEP §803.01, in order to support a restriction requirement, “[e]xaminers must provide reasons and/or examples to support conclusions.” In the present case, the Examiner asserts that the claims of Groups I-VIII are “distinct,” based solely on the unsupported assertion that the alleged different inventions “have different modes of operation, different functions, and different effects.” Applicant contends that the Examiner has made an insufficient showing to support the requirement for restriction.

First, the Examiner appears to have confused the legal standards for “independent” and “distinct” inventions. Whether the inventions have “different modes of operation, different functions, and different effects” is relevant to determining whether the inventions are *independent*, but not to whether the inventions are “distinct” as the Examiner suggests. (See, e.g., MPEP §806.04). It is thus unclear to the applicant whether the Examiner considers the inventions of Groups I-VIII to be “independent” or “distinct,” as those terms are used in MPEP §800, *et seq.*

Second, regardless of whether the Examiner considers the inventions to be “independent” or “distinct,” applicant contends that the lone conclusory statement that the inventions “have

different modes of operation, different functions, and different effects" is an insufficient showing to support the requirement for restriction. The Examiner has merely restated the legal standard, but has not provided any reasons or explanation as to how or why these claims are independent and/or distinct. For these reasons, the restriction requirement should be withdrawn.

Moreover, the restriction requirement should be withdrawn because the Examiner has not made the showing of a "serious burden" on the Examiner, as required by MPEP §803.01. The United States Patent Office Procedure dictates that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." In the present case, the prosecution history of the application belies the notion that there would be any serious burden in continued examination of this entire application, *as the Examiner has already searched and commenced substantive examination* of the very claims that are now made subject to the restriction requirement. All of these claims, Claims 3-14, 17-22, and 30-33, were assigned to the same class and subclass, and were *classified together* in the five-way Restriction Requirement mailed on January 23, 2001. The applicant elected these claims on February 20, 2002. The present Examiner then issued a substantive Office Action for these elected claims, presumably after a search of the prior art, and the applicant responded with an Amendment on November 15, 2002. The Examiner has provided no reasons why the Amendment of November 15, 2002 necessitated this new eight-way restriction requirement. The claim amendments in the November 15th amendment were formal in nature, and many of the claims now subject to restriction were not even amended. The Group V and VI claims (Claims 13-14 and 30-33), for example, were not amended at all in the November 15th Amendment, but are now inexplicably alleged to relate to two distinct inventions.

Because of the lengthy prosecution history of this case, where the claims now subject to restriction were originally classified together and have been progressing through substantive examination, the Examiner should be estopped from asserting that it would constitute a "serious burden" to continue with the prosecution of these claims. To the contrary, imposing an eight-

way restriction on the applicant retroactively at this late date places an unreasonable burden on the applicant. Applicant respectfully requests that the present Restriction Requirement be withdrawn, and asks that the Examiner substantively consider the Amendment filed on November 15, 2002.

Preliminary Amendment

Applicants have added new Claim 34, which is generic to Groups V and VI. Claims 13 and 14 have been amended to depend from Claim 34. Support for these amendments can be found in the Specification, at page 12, line 18, to page 13, line 20, and in Figs. 4a-4d. No new matter has been added.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 341-0036.

Respectfully submitted,

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MARKED UP VERSION OF AMENDMENTS

Claim Amendments Under 37 C.F.R. § 1.121(c)(1)(ii)

13. (Twice Amended) [A] The magnetic field sensor of Claim 34, wherein the sensor [comprising] comprises a matrix of magnetostrictive material that strains under the influence of a magnetic field and imparts stress to at least one rod or fiber of piezoelectric material that is surrounded by the matrix to produce a detectable voltage.

14. (Twice Amended) [A] The magnetic field sensor of Claim 34, wherein the sensor [comprising] comprises at least one rod or fiber of magnetostrictive material that strains under the influence of a magnetic field and imparts stress to a matrix of piezoelectric material surrounding the at least one rod or fiber to produce a detectable voltage.

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